



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of DeWitt

Application No. 10/007,317

Attorney Docket No. 0412-P00912US3

Filed: November 5, 2001

For: METHOD AND APPARATUS FOR
SORTING AND ACQUIRING IMAGE
DATA FOR DOCUMENTS

Examiner: Butler, Michael

Group Art Unit: 3653

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RESPONSE TO OFFICE ACTION

In an Official Action dated October 7, 2003, the Examiner rejected claims 1-23 as obvious over Stevens 5,842,577 in view of Miller 5,147,169 and as obvious over Stevens 5,460,273 in view of Miller 5,147,169. Applicants request that the Examiner reconsider the rejections in light of the following arguments.

Stevens 5,842,577 in view of Miller 5,147,169

In the Official Action, the first rejection of claims 1-23 utilizes Stevens '577 as the primary reference. However, the present application claims priority to Stevens '577. Therefore, Stevens '577 is not prior art against the present application. Accordingly, Applicants request that the Examiner reconsider the rejection of claims 1-23 over Stevens '577 and Miller.

Stevens 5,460,273 in view of Miller 5,147,169

The second rejection relies on a combination of Stevens '273 with Miller. The problem with the combination is that there is no motivation to combine the two references in the manner that the Examiner suggests.

The device in the present application is directed to a semi-automated machine that presents opened envelopes to an operator so that the operator can manually remove the contents. In contrast, the device in Stevens '273 is a fully automated machine that processes 10,000 or more pieces per hour. The object of every aspect of the Stevens '273 device is to do every process as quickly and efficiently as possible while ensuring a high rate of accuracy. Because of this many of the features of the Stevens '273 device are not compatible with a semi-automated device. Nonetheless, the Official Action treats Stevens '273 as though it is simply another reference that teaches document processing, so that its features can be used in any other system. That is not the case.

For instance, claim 1 recites an extractor that opens an envelope and presents the contents to the operator for manual removal. This is completely contradictory to Stevens '273. There would never be any motivation to accomplish one of the steps of the Stevens '273 device manually. It would completely eliminate all of the efficiency of the device. The high-speed automation of Stevens '273 would be wasted. The manual extraction would be so slow that the rest of the process would be a waste of money. The Official Action indicates that it would be obvious to alter Stevens '273 to eliminate the automated extraction station to save the capital expense. This ignores the fact that no one would ever be motivated to spend tens of thousands of dollars on a mostly automated system that could not take advantage of the automation because it uses a manual process.

In short, this is a clear example of taking Applicants' invention and using it as a roadmap to find pieces in the prior art that read on Applicants' invention. It is easy to do, but it is also improper. The burden is on the Examiner to provide evidence from the references that would support the proposed combination. This requires more than simply saying that both references are directed to mail sorting machines. The burden requires some evidence of making the modifications that the Examiner proposes. In



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Examiner proposes. In the present instance, there can be no such evidence, because it would be contrary to the goals of the device in Stevens '273 to modify the device as proposed by the Examiner. Accordingly, Applicants request that the Examiner reconsider the rejection of claims 1-23 based on Stevens '273 in light of Miller.

In light of the foregoing, Applicant believes that this application is in form for allowance. The Examiner is encouraged to contact Applicant's undersigned attorney if the Examiner believes that issues remain regarding the allowability of this application.

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Respectfully submitted,

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CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

I hereby certify that this Response and accompanying papers are being deposited on March 8, 2004 with the United States Postal Service as first-class mail in an envelope properly addressed to Commissioner for Patents, Alexandria, VA 22313-1450.

March 8, 2004
Date of Certificate

Stephen Eland